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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

VON BUHR, MARIA N

ART UNIT PAPER NUMBER

2125

DATE MAILED: 09/12/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/938,802

Applicant(s)

DHARAP, SANJEEV

Examiner

Maria N. Von Buhr

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-23 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-23 and 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

1. Examiner acknowledges receipt of Applicant's response to the previous Office action, received June 23, 2003; which amends the specification, amends claims 1, 2, 7-9, 14, 15, 19, 21-23, 25, 26 and 28, and cancels claims 5 and 24.

2. NOTE: in the instant amendment, claim 23 has been incorrectly identified as "original", when it has instead been currently amended. Applicant should take care to identify this claim as "amended" in all future correspondence.

3. Claims 1-4, 6-23 and 25-28 are now pending in this application.

4. In response to Applicant's amendments and remarks, the objections to the drawings and specification, the 35 U.S.C. §112, second paragraph, rejection of multiple claims, and the 35 U.S.C. §102(b) rejection of all the claims, as being clearly anticipated by Weiser et al. (U.S. Patent No. 5,786,819), are all deemed to have been overcome and are, therefore, withdrawn.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by Applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by Applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by Applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-23 and 25-28 are rejected under 35 U.S.C. §102(b), as being clearly anticipated by Applicant's admitted prior art, of the "Startac® organizer manufactured by Motorola, Inc." (pages 4-5 of the instant specification), and as supported by the "StarTAC clipOn Organizer, Synchronization, and TrueSync Desktop - User's Guide," published by Motorola, Inc. (newly cited).

Specifically, Applicant admits that "Content information in the organizer is organized alphabetically by an alphabetical tag similar to a paper telephone address book, with each entry alphabetized in accordance with its rules of display in a "display name" field. The user may then select individual tabs using the control buttons which identify further levels of granularity in the alphabetization. For example, the opening screen lists a set of tabs, each tab containing three letters (e.g. "ABC," "DEF," etc.) representing the first letter of the last name of each contact. Selecting "ABC" yields another set of tabs with single letter entries (e.g. "A," "B," "C," etc.) and selecting "A" yields all entries presented with the letter "A." If a number of entries are provided for the letter A which exceeds the 10-line display of the device, the device will further sort entries into a pre-configured number of further levels of granularity, for example all entries between "A" and "AI," "AR" and "AT," etc. The organizer will sort, alphabetize, and granularize each letter of the alphabet depending on the number of contacts beginning with that letter. Selection of different controls occurs through use of one of the six control buttons on the device." As evidenced by the StarTAC ... User's Guide, this involves "mapping" each entry to a control input of the display device, as instantly claimed (i.e.; as shown on page 11 of the StarTAC ... User's Guide, the alphabetical letters N-S are "mapped" to the tabs of the displayed card lists, wherein selecting one of the tabs controls the display to show the subset of entries correlated to that particular tab, to allow for further selection by a user).

7. Claims 1-4, 6-23 and 25-28 are rejected under 35 U.S.C. §102(a), as being clearly anticipated by Saarinen et al. (EP-0915604; newly cited).

Specifically, Saarinen et al. teach a "method of searching an electronic phonebook of a cellular phone, where the phonebook contains a multiplicity of names each being made up of one or more alphanumeric characters. The method comprises defining a search template by selecting a letter from a displayed list of the alphabet. The set of distinct data strings, present at the beginning of stored names, which commence with said template and which differ from one another by only their final character, are then identified. The user then selects one of said set of data strings as a new search template. If the number of names matching the new search template is less than some predefined number, then those names are displayed. If not, then the process is repeated using the new extended template" (the abstract). As shown in Figure 4, with accompanying text, list entries are "mapped" to control elements of the display, for selection by a user.

8. Claims 1-4, 6-23 and 25-28 are rejected under 35 U.S.C. §102(e), as being clearly anticipated by Bodnar (U.S. Patent No. 6,417,874; newly cited), see the abstract, and Figs. 7A-E, 8A-F and 9A-B, with accompanying text.

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

10. Any response to this Office action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to the Office at:**

(703) 746-7239 - for formal communications intended for entry, mark "FORMAL";  
(703) 746-7240 - for informal/draft communications; label "PROPOSED" or "DRAFT".

Hand-delivered papers should be brought to Crystal Park II, 2121 Crystal Dr., Arlington, VA, 4th Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maria N. Von Buhr whose telephone number is (703) 305-3837. The Examiner can normally be reached on Monday-Friday between 9:00 A.M. and 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Leo Picard can be reached at (703) 308-0538.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



MARIA N. VON BUHR  
PRIMARY PATENT EXAMINER  
ART UNIT 2125

MNVB  
9/6/03